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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,674	02/28/2000	William H. Robertson	248/225	9434

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EXAMINER
WHITMORE, STACY

ART UNIT	PAPER NUMBER
2812	

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Offic Action Summary	09/514,674	ROBERTSON ET AL.
	Examiner	Art Unit
	Stacy A Whitmore	2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _28 February 2000_ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) _1-22_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _1-22_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _28 February 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _4_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1.   Claims 1-4, 6-7, 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by

Diekman, D. et al. "DISCOE: distributed design and analysis to preserve intellectual

property". (hereinafter referred to as Diekman).

2.   As for claim 1, Diekman taught the invention as claimed, including a method for

selecting electronic components from a remote database over a distributed electronic

network [pg. 57, abstract], comprising the steps of:

storing a plurality of dynamic parts in a remote parts database, each said

dynamic parts representing an individual electronic component [pg. 58, fig. 1, Vendor

Component library];

connecting a user computer to said remote parts database [pg. 58, section II.]; and

embedding a dynamic part from said remote parts database into an application

running on the user's computer [pg. 59, Intellectual property reuse section, pg. 60, left

hand side "DISCOE allow designers to instantiate remote components in their designs

to test the compatibility of the of the remote component".].

1.   As for claim 2, Diekman taught said application running on the user's computer

comprises a software program for modeling an electronic design [see as cited in the

rejection of claim 1].

2.   As for claim 3, Diekman taught said dynamic part functions within said application as a component of a modeled electronic design [see as cited in the rejection of claim 1].

3.   As for claim 4, Diekman taught displaying said dynamic parts graphically on the user's computer, and receiving a selection indication of a dynamic part from the user [pg. 59, graphical design capture and Intellectual property reuse sections].

4.   As for claim 6, Diekman taught said dynamic part is associated with a plurality of component data items [pgs. 58-59, "The major components in DISCOE" section].

5.   As for claim 7, Diekman taught copying said component data items into a local database connected to said user computer upon embedding said dynamic part into the application [see as cited in the rejection of claim 1].

6.   As for claim 11, Diekman taught said embedded dynamic part comprises a link to associated data stored in said remote parts database [see as cited in the rejection of claim 1].

7.   As for claim 12, said embedded dynamic part comprises a link to associated data stored in a database of a supplier or distributor of the electronic component represented by said dynamic part [see as cited in the rejection of claim 1].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diekman, D. et al. "DISCOE: distributed design and analysis to preserve intellectual property". (hereinafter referred to as Diekman).

9.   As for claim 5, Diekman taught the invention substantially as claimed, including the method for selecting electronic components from a remote database over a distributed electronic network [see as cited in the rejections of claims 1-4]. Diekman did not specifically teach said selection indication is performed by the user placing a graphical icon representing the selected dynamic part into said application. However, Diekman taught that the displaying and receiving the dynamic parts graphically on the user's computer [pg. 59, graphical design capture and Intellectual property reuse sections] and embedding a dynamic part from said remote parts database into an application running on the user's computer [pg. 59, Intellectual property reuse section, pg. 60, left hand side "DISCOE allow designers to instantiate remote components in their designs to test the compatibility of the of the remote component".]. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made for the user's selection indication to be performed by the user placing a graphical icon representing the selected dynamic part into said application because typical graphical design utilizes objects or icons to be placed into applications such as those used for layout and floorplanning and commercially available products such as Labview by National Instruments.

10.   Claims 8-10 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Diekman, D. et al. "DISCOE: distributed design and analysis to preserve intellectual property". (hereinafter referred to as Diekman) in view of Walker et al. (5,862,223) (hereinafter referred to as Walker).

11.   Walker was cited in the IDS dated May15, 2000.

12.   As for claim 8, as applied to claims 1-7, Diekman taught the invention substantially as claimed, including a method for selecting electronic components from a remote database over a distributed electronic network [see as cited in the rejections of claims 1-7] . Diekman did not specifically teach said local database comprises a resource planning database, said method further comprising steps of entering a component represented by said dynamic part into a parts approval process, and comparing the component with data records of components already stored in said resource planning database. However, Walker taught said local database comprises a resource planning database, said method further comprising steps of entering a component represented by said dynamic part into a parts approval process, and comparing the component with data records of components already stored in said resource planning database [see fig. 2, col. 14, lines 14-67, col. 17, and col. 20]. [Note that examiner interprets Walker's database information as reading on the claimed dynamic parts information because the intellectual property associated with the dynamic parts of Diekman is merely user definable information stored in a database such as that disclosed by Walker].

13.   As for claim 9, Walker taught updating said local database from said remote parts database by moving data from said remote parts database to said local database without user intervention [fig. 5, and col. 16, lines 32-44].

14.   As for claim 10, Walker taught updating said local database from said remote parts database by moving data from said remote parts database to said local database in response to a user request for said data [fig. 5, and col. 16, lines 32-44].

15.   As for claim 13, Diekman taught embedding a set of said dynamic parts into said application running on the user's computer [see as cited in the rejection of claim 1], Diekman did not specifically teach generating an electronic bill of materials (BOM) based on said dynamic parts in said application, said BOM comprising a link to either said remote parts database or another remote database for each dynamic part.

However, Walker taught generating an electronic bill of materials (BOM) based on said [user selection] which comprises a link to either a remote or other database [see as cited in the rejection of claim 9 and also 14, lines 20, 45 and lines 61-65]. Walker's database information would apply to the dynamic parts of Diekman because the intellectual property associated with the dynamic parts of Diekman is merely user definable information stored in a database such as that disclosed by Walker [see Walker as cited in the rejection of claims 8-10]. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include - the generating an electronic bill of materials (BOM) based on said dynamic parts in said application, said BOM comprising a link to either said remote parts database or another remote database for each dynamic part – because the BOM of dynamic parts would enhance the design process and streamline the commerce between user and provider of the intellectual property [see Diekman pg. 57, right hand side; and pg. 59, left hand side, lines 1-10].

16.   Claims 14-22 are apparatus claims that correspond to the method claims 1-13, and are rejected for the same reasons as cited in the rejection of claims 1-13.

17.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dalpasso, "Specification and validation of distributed IP-based designs with JavaCAD"
Dong-Eun Lee, "CADIC: computer-aided design on internet with cryptosystem".
Zorian, "Test requirements for embedded core-based systems and IEEE P1500".
Larson, "Managing design processes: a risk assessment approach".

1.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy A Whitmore whose telephone number is (703)
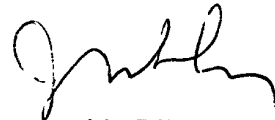
305-0565. The examiner can normally be reached on Monday-Thursday, alternate Friday 6:30am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Niebling can be reached on (703) 308-3325. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Stacy Whitmore
February 21, 2002

John F. Niebling
Supervisory Patent Examiner
Technology Cent...